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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,522	12/03/2003	Yuichiro Murayama	Q78604	4994
23373 7590 04/18/2007 SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			EXAMINER HARRIS, GARY D	
			ART UNIT	PAPER NUMBER
			1773	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/18/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/725,522

Applicant(s)

MURAYAMA ET AL.

Examiner

Gary D. Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/1/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Finality Withdrawn

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-12 & 14-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,767,613 and U.S. Patent No. 6,773,789. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patents describes a magnetic recording medium with similar features and compositions as the '522 application. Examiner notes that many of the claims could be rejected based on applicants' prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 & 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seki et al. US 5,712, 028 and further in view of Inaba et al. US 6,074,724.

As to Claim 1, 2 & 4 Seki et al. '028 discloses a magnetic recording media modifying the urethane by means of radiation as the source for curing (Col. 12, Line 10-69). A lower undercoat layer with nonmagnetic particles in a binder is disclosed (Col. 3, Line 12-21). A ferromagnetic powder in a binder with a glass transition temperature between -20 and 80 C and a thickness of magnetic layers from .2 to 5 microns is disclosed (Col. 13, Line 29-43). Seki et al. '028 does not disclose micro projections having a height of 10-20 nm or a glass transition temperature between 100 and 200 C. However, Inaba et al. '724 teach the importance of dispersibility of magnetic powder and inorganics to enhance polyurethane binder resulting in improved surface properties and projections in the range of 10-20 nm (Col. 17, Line 42-52). Seki et al. '028 discloses an ideal glass transition temperatures of 50-200 C (Col. 8, Line 12). It would have been obvious to one skilled in the art to minimize the micro projections and disperse the powder as

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taught by Inaba et al. '724 in the Seki et al. '028 invention to improve dispersion the polyurethane resin and hardness and elasticity.

As to Claim 3, Seki et al. '028 discloses an ideal range of viscosity for the coating material to be between 5 to 100 cPs (100 mPa). However, the patentability of a product is independent of how it was made. Ex parte Jungfer 18 USPQ 1796, 1800 (BPAI 1991); Bristol-Myers Co. v. U.S. International Trade Commission 15 USPQ 2d 1258 (Fed. Cir. 1989). The burden is on applicants to show product differences in product by process claims. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

As to Claims 5, 6, 7, 8 & 22, Seki et al. '028 discloses no particular limit to the binder resin including cyclic structures (cyclohexanone etc.) and aromatic hydrocarbons (Col. 10, Line 14-46). Additionally, acryl type double bond is well known for improving the ratio of cross linking (Col. 12, Line 42-48).

As to Claims 9, 10, 11, 16, 'Seki et al. '028 disclose a nonmagnetic underlayer composed of a powder in a binder with thickness from 0.5-2.0 microns (Col. 2, Line 17-27).

As to Claim 12, 'Seki et al. '028 discloses the use of ferromagnetic powders including iron, nickel and cobalt and alloys thereof (Col. 6, Line 6-19).

Claim 13 (Canceled by applicant)

As to Claims 14 & 15, Seki et al. '028 disclose a magnetic layer thickness changing from 0.08 to .20 microns (Col. 19, Line 55-57).

As to Claims 17 & 20, Seki et al. '028 discloses the use of carbon black as an anti-static agent (Col. 16, Line 2-11).

As to Claim 18, Seki et al. '028 discusses the undercoat layer having a thickness between 0.5 and 2.0 microns (Col. 4, Line 50-51):

As to Claim 19, Seki et al. '028 discusses that the undercoat layer and the magnetic layer can be the same (Col. 7, Line 55-61).

As to Claim 21, Seki et al. '028 discloses acryl type double bond is well known for improving the ratio of cross linking (Col. 12, Line 42-48) he does not specifically cite the molecular weight. However, the patentability of a product is independent of how it was made. *Ex parte Jungfer* 18 USPQ 1796, 1800 (BPAI 1991); *Brystol-Myers Co. v. U.S. International Trade Commission* 15 USPQ 2d 1258 (Fed. Cir. 1989). The burden is on applicants to show product differences in product by process claims. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary D. Harris whose telephone number is 571-272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol D. Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GH

CAROL CHANEY
SUPERVISOR

